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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/787,111	02/27/2004	Futoshi Koike	ASA-1163	5065
24956	7590	12/01/2006		
MATTINGLY, STANGER, MALUR & BRUNDIDGE, P.C. 1800 DIAGONAL ROAD SUITE 370 ALEXANDRIA, VA 22314				
			EXAMINER LUDWIG, MATTHEW J	
			ART UNIT 2178	PAPER NUMBER

DATE MAILED: 12/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/787,111

Applicant(s)

KOIKE ET AL.

Examiner

Matthew J. Ludwig

Art Unit

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 6, 9, 10 and 16-20 is/are rejected.
- 7) ☒ Claim(s) 4, 5, 7, 8, 9, 11-15 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is in response to the amendment filed 9/18/2006.
2. Claims 1-20 are pending in the application. Claims 1, 18, and 19, are independent claims.
3. Claims 1-19 rejected under 35 U.S.C. 102(b) as being anticipated by Day have been withdrawn pursuant to applicant's amendment.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. **Claims 2, 6, 9, 11, 14, 16, and 17, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

In reference to dependent claim 2, the claim recites the phrase 'defines classification of an application through which said document to be reviewed is prepared'. The phrase fails to accurately point out and distinctly claim the subject matter. The language is vague and indefinite. More specifically, the Examiner is confused as to what is meant by the phrase 'said document to be reviewed is prepared'. Appropriate correction is required.

In reference to dependent claim 6, the claim recites the phrase 'an editor which, when a solution comment against a comment in said minutes'. The phrase fails to accurately point out and distinctly claim the subject matter. The language is vague and indefinite. More specifically, the Examiner is confused by the phrase 'an editor which, when' and what is meant by 'solution comment *against* a comment'. Appropriate correction is required.

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In reference to dependent claim 9, the claim recites the phrase ‘described in said minutes from said user and giving said priority order to said minutes’. It is unclear what is meant by the word giving within the context of the dependent claim. The phrase is vague and indefinite and fails to accurately describe how the priority order is sent to said minutes. Appropriate correction is required.

In reference to dependent claim 11, the claim is replete with grammatical errors making it difficult for the Examiner to clearly understand what is being claimed. More specifically, the claim recites the following phrases, ‘an editor which, when’, ‘solution comments against comments’, ‘are input from said user, gives said solution’, ‘in said minutes, preparing a pending issue list adapted to put together comments’. The grammar errors located throughout the dependent claim leaves the limitations vague and indefinite. Appropriate correction is required.

In reference to dependent claim 14, the claim recites the phrase, ‘in said pending issue list, searches, from said storage, position information’. The claim includes commas when it is unclear if the commas are needed to separate the multiple steps required within the document review support apparatus. It leaves the claim vague and indefinite.

In reference to dependent claim 16, the claim recites the limitation ‘a management unit for managing a difference caused in said document to be reviewed before and after edition’. It is unclear to the Examiner what is meant by the term ‘difference caused’ within the dependent claim. The term leaves the limitation vague and indefinite. Appropriate correction is required.

In reference to dependent claim 17, the claim recites the limitation ‘said acquiring unit stores in said storage a plurality of pieces of said position information and a plurality of pieces of comments by correlating them to each other’. The Examiner is unclear as to the meaning of the

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term 'pieces of said position information' and 'pieces of comments'. The terms leave the claim vague and indefinite for failing to accurately describe what 'a piece' of something means.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claims 1-3, 6, 9, 10, 16, 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beezer et al., USPN 7,028,267 filed (12/7/1999).**

In reference to independent claim 1, Beezer teaches:

Non-modifiable content as a separate file apart from the annotation file. The annotation file has similar constituent elements to that of annotation of Figure 8A. Annotation file may include a file portion that indicates to which non-modifiable document it is linked. One file may store all annotation for a user with the non-modifiable content portions being stored separately (compare to "a storage which stores position-attribute information management information defining items of position information to be acquired from document to be reviewed..."). See column 11, lines 1-35.

A user may position a cursor over the object then select the object by clicking a mouse button or by operating a designation source (compare to "*an input unit which receives, from a user, an input including a designation of a position in said document to be reviewed at which*").

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a comment is to be added). See column 6, lines 30-45. The reference fails to explicitly state a designation of a position; however, Beezer discloses the cursor being placed within a paper novel. The document reader window may comprise a variety of portions including a title bar and body. Similar to an actual book, margins appear around the displayed text. See column 6, lines 15-30. The reference provides a proficient suggestion of a designation of a position within a document with the known locations of words, paragraphs, and titles, of a document. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have utilized the well known document positions as taught by the ebook of Beezer to suggest a generic designation of a position based upon the selection from a cursor and provide the user with an enhanced user interface for navigation/selection of a objects in various positions of a document.

The system determines which object the user selected. This step relates to the conversion of the physical coordinates from the display device to coordinates inside the reader window. From this conversion, the object selected by the user is known. The determination is as to the file position of the selected object. The file position may include the first byte of the selected object. Alternatively, the file position may be the first byte of the last character of the selected object (compare to “*an acquiring unit, responsive to said input from said input unit, which acquires said position information from a position designated by said user in accordance with said position-attribute management information...*”). See column 8, lines 50-67.

Alternatively, users may use a search capability to locate annotations on any number of books/documents from a centralized Annotations Index page (compare to “*a search unit, coupled with said input unit and said acquiring unit, which search from the position-attribute*

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management information and the comment-solution management information stored in said storage..."). See column 8, lines 10-17.

The navigation portion may be integral with body portion. Body portion includes text cursor, designating the location where new text will be entered. Also, body portion includes previously entered text. To indicate that text has been entered, icon is displayed juxtaposed to the line containing the selected object (compare to "*a display unit, coupled with the search unit, which collectively displays at least position information and a comment associated with said document so as to correlate said at least position information and the comment to each other*"). See column 7, lines 29-54.

In reference to dependent claim 2, Beezer teaches:

Similar to an actual book, margins appear around the displayed text. As referred to herein, the displayed elements may be independently referenced. See column 6, lines 1-25.

In reference to dependent claim 3, Beezer teaches:

The display window is generated in response to a selection of "Add Note". Window includes body portion as well as a navigation portion. The two portions are divided from each other. See column 7, lines 30-40.

In reference to dependent claim 6 and 9, Beezer teaches:

The display window is generated in response to a selection of "Add Note". Window includes body portion as well as a navigation portion. The two portions are divided from each other. See column 7, lines 30-40.

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In reference to dependent claim 10 and 16, Beezer teaches:

When selected, navigation option labeled “Previous” switches the displayed annotation to the previous annotation. Similarly, when selected, navigation option labeled “Next” switches the displayed annotation to the next annotation. See column 7, lines 40-47.

In reference to dependent claim 17, Beezer teaches:

The navigation portion may be integral with body portion. Body portion includes text cursor, designating the location where new text will be entered. Also, body portion includes previously entered text. To indicate that text has been entered, icon is displayed juxtaposed to the line containing the selected object (compare to “*a display unit, coupled with the search unit, which collectively displays at least position information and a comment associated with said document so as to correlate said at least position information and the comment to each other*”).

See column 7, lines 29-54.

In reference to claim 18 and 19, the claims recite similar limitations to those claimed within independent claim 1. Therefore, the claims are rejected under similar rationale.

In reference to dependent claim 20, Beezer teaches:

Alternatively, users may use a search capability to locate annotations on any number of books/documents from a centralized Annotations Index page (compare to “*a search unit, coupled with said input unit and said acquiring unit, which search from the position-attribute management information and the comment-solution management information stored in said storage...*”). See column 8, lines 10-17.

Response to Arguments

8. Applicant's arguments with respect to claims 1-19 have been considered but are moot in view of the new ground(s) of rejection.

Applicant amended the independent claims and thus changed the scope of the invention when read as a whole. Therefore, the rejections have been adjusted accordingly.

Allowable Subject Matter

9. Claims 4, 5, 7, 8, 9, and 11-15, are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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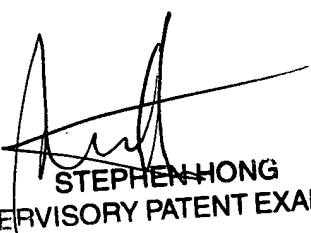
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew J. Ludwig whose telephone number is 571-272-4127.

The examiner can normally be reached on 9:00am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on 571-272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

ML


STEPHEN HONG
SUPERVISORY PATENT EXAMINER